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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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EXAMINER

MEHTA, ASHWIN D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1638 | |

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|-----------------|--------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 09/645,337 | WU ET AL |
| | Examiner | Art Unit |
| | Ashwin Mehta | 1638 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication
- Failure to reply within the set or extended period for reply will by statute cause the application to become ABANDONED (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication even if timely filed may reduce any earned patent term adjustment. See 37 CFR 1.704(b)

Status

1) Responsive to communication(s) filed on 25 August 2000.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-21, 23, 25, 27 and 28 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) _____ is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) 1-21, 23, 25, 27 and 28 are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved by the Examiner.
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

- Certified copies of the priority documents have been received
- Certified copies of the priority documents have been received in Application No. _____
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) Notice of References Cited (PTO-892) 4) Interview Summary (PTO-413) Paper No(s) _____

2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) Notice of Informal Patent Application (PTO-152)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) Other

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 and 11-20, drawn to a method of regulating gene expression in a transgenic plant, comprising introducing into the plant a first chimeric nucleotide sequence comprising a first regulatory element operatively linked to a gene of interest, and a controlling sequence, and a second chimeric nucleotide sequence comprising a second regulatory sequence operatively linked to a nucleotide sequence encoding histone deacetylase and a DNA binding protein, said DNA binding protein interacting with said controlling sequence; an isolated nucleotide sequence; a chimeric construct comprising said isolated nucleotide sequence operatively associated with a regulatory element; transgenic plant cells and plants produced by said method, classified in class 536, subclass 23.6, for example.
- II. Claim 10, drawn to an isolated amino acid sequence, classified in class 530, subclass 350, for example.
- III. Claim 21, drawn to a method of regulating gene expression in a plant, which comprises interaction of a DNA binding protein with a native controlling sequence, classified in class 435, subclass 468, for example.
- IV. Claim 23, drawn to a method for identifying an endogenous DNA binding protein in any organism, classified in class 435, subclass 6, for example.
- V. Claims 25 and 27, drawn to a method for altering the development of any organism, and for altering the biochemical, physiological or developmental pathway of any organism, classified in class 800, subclass 21, for example.

VI. Claim 28, drawn to a method for identifying a DNA binding protein in a plant, comprising introducing into a plant a chimeric nucleotide sequence operatively associated with a nucleotide sequence encoding histone deacetylase fused to a nucleotide sequence of interest of unknown function, classified in class 800, subclass 278, for example.

The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions have different modes of operation and effect. The isolated nucleotide sequence of Group I is not required by the isolated amino acid sequence of Group II. The introduction of a nucleotide sequence encoding a DNA binding protein of the methods of Group I is not required by Groups II, IV, and VI. The isolated amino acid sequence of Group II is not required by any of the other groups. The interaction of the DNA binding protein with native sequences of the method of Group III is not required by the methods and products of Groups I, II, V, and VI. The non-plant organisms of the methods of Groups IV and V are not required by the other groups. The identification of DNA binding proteins of Groups IV and VI are not required by the other groups. The nucleotide sequence of unknown function of the method of Group VI is not required by any of the other groups. Further, the nucleotide and amino acid sequence of all the groups can be produced by alternative means, such as chemical synthesis.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-VI, restriction for examination purposes as indicated is proper.

Applicants are reminded that nucleotide sequences encoding different proteins are structurally distinct chemical compounds and are unrelated to one another. These sequences are thus deemed to normally constitute **independent and distinct** inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such nucleotide sequence is presumed to represent an independent and distinct invention, subject to a restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141 et seq.

Should Group I or II above be elected, Applicant is additionally required to select a single nucleotide sequence or amino acid sequence for said Group. This requirement is not to be construed as a requirement for an election of species, since each nucleotide and amino acid sequence is not a member of single genus of invention, but constitutes an independent and patentably distinct invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this or earlier communications from the examiner should be directed to Ashwin Mehta, whose telephone number is 703-306-4540. The examiner can normally be reached on Mondays-Thursdays and alternate Fridays from 8:00 A.M to 5:30 P.M.. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Amy Nelson, can be reached at 703-306-3218. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3014 and 703-872-9306 for regular communications and 703-872-9307 for After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

Ashwin Mehta
ASHWIN D. MEHTA, PH.D
PATENT EXAMINER

January 29, 2002